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09/679,070	10/05/2000	Takeshi Morikawa	018656-186	7739
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BURNS DOANE SWECKER & MATHIS L L P			POON, KING Y	
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DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/679,070

Applicant(s)

MORIKAWA ET AL.

Examiner

King Y. Poon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-15 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 7-12, 14, 15 are rejected under 35 U.S.C. 102(b) as being anticipated by DeHority (US 5,129,639).

Regarding claim 1: DeHority teaches a printing system (fig. 1) including a printer (16, fig. 1) that operates in either a first operating environment (e.g., substitute, column 3, lines 40-45) and a second operating environment (e.g., strict requirement/notify me, column 3, lines 40-45) that is different from the first operating environment, the printing system comprising: a print parameter prohibiting means (the information in the control program, column 2, lines 65-68, that determines a mismatch, column 4, lines 20-25) that prohibits use of a printing parameter (e.g., a duplex requirement, column 4, lines 5-6) associated with a print job (column 3, line 23); an operating environment detector (the software that determines strict or best, 72, fig. 2B) that determines whether the printer operating environment is the first operating environment or the second operating environment; a parameter determiner (the software that determines print job

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requirement that is mismatched, column 3, lines 29-40, fig. 2A, fig. 2B) that receives a print job and determines whether a printing parameter to be used in the print job is prohibited by the print parameter prohibiting means; and a controller (20, fig. 1) that, when the parameter determiner determines that a printing parameter is prohibited (mismatch at 62, fig. 2B) and the operating environment determining means detects that the environment is the first operating environment, (best at 72, fig. 2B) prohibits processing of the print job (the print job is processed with a substitute parameter, not the prohibited print parameter, column 4, lines 30-40) using the print parameter prohibited.

Regarding claim 2: DeHority teaches the controller forcibly cancels the printing parameter that is prohibited and changes the parameter to another available printing parameter to perform the print job (column 4, line 31).

Regarding claim 7: DeHority teaches a designator (the program that set the printer in different mode) that designates the first operating environment (e.g., the printer is at substitute mode, column 3, line 44) and the second operating environment (e.g., the printer is at strict requirement mode, column 3, lines 44-45).

Regarding claim 8: DeHority teaches wherein the designator designates a time period (column 4, line 26).

Regarding claim 9: DeHority teaches wherein the operating environment detector determines environment (e.g., substitute, column 3, lines 40-45 or strict requirement/notify me, column 3, lines 40-45) based on environment (how the printer is

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set up/programmed to the serve the network, column 3, lines 40-50) of network to which the printer is connected.

Regarding claim 10: DeHority teaches wherein the print parameter prohibiting means operates according to a detection detected by a sensor (the device in the processor that sense the right signal is called for, column 8, lines 13-15) located in the printer (16, fig. 1).

Regarding claim 11: DeHority teaches wherein the print parameter prohibiting means operates by a manual operation (a user/operator sets the printer configuration, column 4, lines 20-25; i.e., a user determines what is available in the printer) by a user.

Regarding claim 12: DeHority teaches wherein the print parameter prohibiting means is located in the printer (column 2, lines 50-69).

Regarding claim 14: DeHority teaches A print job management method of a printing system including a printer (16, fig. 1) that operates in either a first operating environment (e.g., substitute, column 3, lines 40-45) and a second operating environment (e.g., strict requirement/notify me, column 3, lines 40-45) that is different from the first operating environment, comprising steps of: setting a prohibit printing parameter (e.g., a duplex requirement, column 4, lines 5-6, associated with a print job cannot be performed by the printer, 46, fig. 2A) associated with a print job; detecting whether printer operating environment (detecting strict or best, 72, fig. 2B) is the first operating environment or the second operating environment; determining (determining mismatch, fig. 2A, fig. 2B) whether a printing parameter to be used in the print job is prohibited; and prohibiting processing of the print job (the print job is processed with a

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substitute parameter, not the prohibited print parameter, column 4, lines 30-40) using the print parameter prohibited, when the determining step determines that a printing parameter is prohibited (mismatch 62, fig. 2B) and the detecting step detects that the environment is the first operating environment (best at 72, fig. 2B).

Regarding claim 15: DeHorty teaches a printing system (fig. 1) including a printer, (16, fig. 1) comprising: an operating environment setting means (user's computer, column 3, lines 40-50, 10, fig. 1) that sets a first operating environment (e.g., substitute, column 3, lines 40-45) as the operating environment for the printer, as well as a second operating environment (e.g., strict requirement/notify me, column 3, lines 40-45) that is different from the first operating environment; a print parameter prohibiting means (the information in the control program, column 2, lines 65-68, that determines a mismatch, column 4, lines 20-25) that prohibits use of a printing parameter (e.g., a duplex requirement, column 4, lines 5-6) associated with a print job (column 3, line 23); an operating environment detector (the software that determines strict or best, 72, fig. 2B) that determines whether the printer operating environment is the first operating environment or the second operating environment; a parameter determiner (the software that determines print job requirement that is mismatched, column 3, lines 29-40, fig. 2A, fig. 2B) that determines whether or not a printing parameter of a print job is prohibited by the print parameter prohibiting means; and a controller (20, fig. 1) that, when the parameter determiner determines that a printing parameter is prohibited (mismatch at 62, fig. 2B), executes a different print mode (the print job is processed with a substitute parameter, not the prohibited print parameter, column 4, lines 30-40) based

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on the determination by the operating environment detector (determines that best is to be used, 72, fig. 2B).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3, 4, 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeHority as applied to claim 1 above, and further in view of Tang et al (US 6,160,629).

Regarding claim 3: DeHority does not teach the controller forcibly deletes the print job including the printing parameter prohibited.

Tang, in the same area of printing, teaches deleting print job (note; a print job includes printing parameter) (column 4, lines 50-55).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified DeHority's printing system to include: the controller forcibly deletes the print job including the printing parameter prohibited.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified DeHority's printing system by the teaching of Tang because of the following reasons: (a) it would have prevented the printer from running out of memory; and (b) it would have allowed the printer to function properly by having enough memories to store other useful print jobs.

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Regarding claim 4: DeHority does not teach the controller goes on keeping the print job including the printing parameter prohibited.

Tang, in the same area of printing, teaches keeping a print job (note; a print job includes printing parameter) (column 4, lines 37-40).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified DeHority's printing system to include: the controller goes on keeping the print job including the printing parameter prohibited.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified DeHority's printing system by the teaching of Tang because of the following reasons: (a) it would have allowed the print job to be printed in the future, as taught by Tang at column 4, lines 37-40; and (b) it would have allowed the print job to be printed when the printer is configured to print the prohibited parameters in the future (column 4, lines 20-25, DeHority).

Regarding claim 5: DeHority teaches where a printing parameter is determined by the parameter determiner (the software that determines print job requirement that is mismatched, column 3, lines 29-40, fig. 2A, fig. 2B) to be prohibited and the operating environment is determined by the operating environment determining means to be the second operating environment (e.g., strict requirement/notify me, column 3, lines 40-45), the controller notifies a warning message (column 4, lines 25-27).

DeHority does not teach to display the warning message.

Tang, in the same area of printing, teaches it is well known to convey a message to a person is by displaying (column 5, lines 25-30).



Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified DeHority's printing system to include: display the warning message.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified DeHority's printing system by the teaching of Tang because of the following reasons: (a) it would have provided a fast and reliable way of sending the warning message to the operator.

6. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeHority as applied to claim 1 above, and further in view of Hower, Jr. et al. (US 5,467,434).

Regarding claim 13: DeHority does not teach wherein the print parameter prohibiting means is a program installed in a computer that transfer the print job to the printer.

Hower, in the same area of print parameter prohibiting, teaches a print parameter prohibiting program (37, fig. 2, column 7, lines 25-55) that is installed in a computer (15-1, fig. 2) that transfer the print job to a printer (column 3, lines 35-50).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified DeHority's printing system to include: wherein the print parameter prohibiting means is a program installed in a computer that transfer the print job to the printer.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified DeHority's printing system by the teaching of

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Hower, Jr. et al. because of the following reasons: (a) it would have reduced the work load of the printer processor such that the printer processor would allocate more time to process the print job to speed up the printing process; and (b) it would have increase the usable life of the printer/processor by reducing the work load of the printer.

***Allowable Subject Matter***

7. Claims 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

8. Applicant's arguments filed 11/1/2004 have been fully considered but they are not persuasive.

With respect to applicant's argument that mode of operation is not operating environment because "the mode of operation" is not operating conditions that surrounds the printer, has been considered.

In reply: Surround according to American Heritage Dictionary, has the meaning of enclose or confine on ALL SIDES so as to bar escape or outside communication. Since the mode of operation of the printer is controlled a program programmed by a human, the operation of the printer is confine by the program such that the printer's

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operation cannot escape the program. In short, the mode of operation confines all sides of the printer's operation.

Furthermore, page 13, lines 24-26, specification teaches "setting/programming a time frame" for the printer is setting the "operating environment" for the printer. Since the operating environment is programmed into the printing system, the operating environment is internal of the printing system after the operating environment is being set/programmed using a touch panel of the printing system.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Conclusion***

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is (703) 305-0892.

3/11/05

A handwritten signature in black ink, appearing to read 'King Y. Poon', written in a cursive style.

**KING Y. POON  
PRIMARY EXAMINER**